

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant: VALLSTROM et al. Examiner: Patel, N.
Serial No.: 10/522,480 Group Art Unit: 2617
Filed: January 26, 2005 Docket No.: KOLS.172US

Confirmation No.: 3828 Customer No.: 76385

Title: METHOD AND RADIO TERMINAL EQUIPMENT ARRANGEMENT OF INDICATING INCOMING CONNECTION

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being transmitted to the U.S. Patent and Trademark Office via the Office electronic filing system in accordance with 37 CFR 1.6(a)(4) on March 9, 2009.

By: Tracey M. Dotter
Tracey M. Dotter

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005, on the New Pre-Appeal Brief Conference Pilot Program.

Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Both of the § 103(a) rejections are based on at least a combination of the teachings of U.S. Patent No. 6,714,233 to Chihara *et al.* (hereinafter "Chihara") with those of U.S. Patent No. 7,110,535 to Bodley *et al.* (hereinafter "Bodley"). For example, each of the independent claims (Claims 1, 10, 19, and 20) is rejected based at least on this combination.

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements

required for a *prima facie* obviousness rejection. Although each of the independent claims is rejected in the final Office Action (dated December 9, 2008) in view of at least Chihara and Bodley, neither of these references teaches certain of the claimed limitations.

The example limitations at issue for purposes of this request for review relate to indicating an incoming connection request in one or more peripheral units but not in the cellular core unit, as claimed in each of the independent claims. To establish a *prima facie* § 103(a) rejection of at least the independent claims, these limitations must be present, as the Examiner alleges, in Chihara, Bodley, or, for independent Claims 1 and 10, in the additionally relied upon teachings of Bonta.

Independent Claims 1, 10, 19, and 20

None of the cited portions of Chihara teach or suggest these limitations. First, the relied-upon portion of Chihara at Fig. 1, Col. 10, lines 9-13, teaches that with the arrival of an incoming call at the mobile telephone device 11 (asserted as corresponding to the claimed cellular core unit), the incoming call arrival announcing signal, including the telephone number of the calling party, is then sent to the wrist watch-type information apparatus 12. There is no teaching or suggestion that an incoming connection request is **not indicated in** the mobile telephone device 11, and instead Chihara teaches that the connection request is **always** indicated in the mobile telephone device. Even though the incoming call arrival announcing signal is sent to the wrist watch-type information apparatus (asserted as corresponding to a claimed peripheral device), this does not mean that the incoming call arrival announcing signal is not indicated in the mobile telephone. The fact that a user would be able to check the name of the calling party using the LCD 44 of the wrist watch-type information apparatus does not prevent the user from using the mobile telephone to check the incoming call.

The further reliance on Chihara teaching that the image is transmitted to or from another party only by one device at Col. 12, lines 19-23, also fails to correspond to the claim limitations directed to indicating an incoming connection request. Transmitting an

image as taught by Chihara does not correspond to the claimed incoming connection request. Rather, Chihara clearly teaches at Col. 11, lines 48-55, that:

First, with the arrival of an incoming [c]all [which is asserted as corresponding to the claimed indicating an incoming connection request] at the mobile telephone device 11A, the RF unit 27 demodulates the baseband signal from the signal received through the antenna 26, and the W-CDMA baseband processing unit 28 extracts the coded image data and the coded voice data independently of each other from the baseband signal. The coded image data is the image of the face of the calling party and the coded voice data is the voice of the calling party, for example.

Therefore, the cited portion of Chihara at Col. 12 merely teaches that after the arrival of an incoming call, in the mobile telephone device 11A, the image (that has been extracted from the coded image data independently of the coded voice data) can be transmitted to or from the other party by the mobile telephone device 11A or the wrist watch-type information apparatus and the voice is output from the speaker. While Chihara is solely relied upon as teaching these limitations and fails to do so, none of the other asserted references has been shown to teach or suggest indicating an incoming connection request in one or more peripheral units but not in the cellular core unit. Without a presentation of correspondence to at least these limitations, the rejections are improper.

Independent Claims 19 and 20

Neither Chihara nor Bodley has been shown to teach further limitations of Claims 19 and 20. Specifically, neither of the asserted references teaches indicating an incoming connection request on a cellular core unit when, during the indication concerning the incoming connection request to the peripheral unit, the LPRF connection between the cellular core unit and the peripheral unit is lost. The cited portion of Bodley merely teaches transferring voice signals from a cell phone to a headset without any suggestion of transferring signals or requests from the headset to the cell phone. Also, Bodley does not teach or suggest transferring indications on incoming connection requests to or from the headset. Instead, Bodley teaches at Col. 10, lines 27-29 that the connection request is always indicated in the cell phone (asserted cellular core unit). Thus, the asserted

modification of Chihara with Bodley on pages 28 and 31 of the Office Action fails to correspond to several of the claimed limitations and does not correspond to the claimed invention. Without correspondence to each of the claim limitations, the § 103(a) rejection of at least these claims is improper.

Independent Claims 1 and 10

Further limitations of independent Claims 1 and 10 that are not taught as asserted by Chihara (at page 8 of the Office Action) are those directed to establishing an incoming connection to the peripheral unit in which the incoming connection request has been accepted. Chihara instead teaches that the incoming connection is established to the headset after the incoming connection request has been accepted in the wrist watch-type information apparatus 12 or in the mobile telephone device 11 - a different peripheral unit than that in which the incoming connection request has been accepted. The again-cited portion of Chihara merely teaches that the wrist watch-type information apparatus 12 transfers a response instruction to the mobile telephone device 11, which processes the instruction for responding. Contrary to the assertion in the Advisory Action, there is no suggestion that the wrist watch-type apparatus has accepted the incoming call, and instead, the cited portion teaches that the response instruction may be to reject the call by requesting that the calling party call again later. Moreover, Chihara specifically teaches that the call is established to the headset (Col. 9 line 62 – Col. 10 line 2) while image data is also sent to the wrist watch-type information device such that the user can make speech while at the same time look at the received image of the other party displayed on the wrist watch-type information apparatus. Chihara thus teaches that the incoming connection is established to the headset after the incoming connection request has been accepted in the wrist watch-type information apparatus. The display of the image of the other party in the wrist watch-type apparatus does not affect the establishment of the incoming call to the headset - a different peripheral unit than that in which the incoming connection request has been accepted. Thus, Chihara, or any of the other asserted references, has not been shown to teach or suggest establishing an incoming connection to the peripheral unit in which the incoming connection request has been accepted. Without a presentation of

correspondence to at least these limitations, the rejections are improper.

None of the asserted references teaches or suggests indicating an incoming connection request in one or more peripheral units but not in the cellular core unit. Therefore, it is respectfully submitted that there is an omission of an essential element needed for a *prima facie* obviousness rejection. Because none of the asserted references involves or otherwise addresses indicating an incoming connection request in one or more peripheral units but not in the cellular core unit, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) required for a *prima facie* rejection.

It is Appellant's position that the Examiner's reliance on Chihara, Bodley, and Bonta in the § 103(a) rejections as teaching indicating an incoming connection request in one or more peripheral units but not in the cellular core unit is inappropriate, as none of the references addresses this.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections based upon Chihara, Bodley, and Bonta are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC

Attorneys at Law
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700 (tel.)

By: /Erin M. Nichols/
Name: Erin M. Nichols
Reg. No.: 57,125